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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236

7590 05/17/2007  
Attention: Yen Tong Florczak  
Office of Intellectual Property Counsel  
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EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
05/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/771,054	MALLO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Blessing M. Fubara	1618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-43 is/are pending in the application.
- 4a) Of the above claim(s) 37 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-38, 38-41 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

Examiner acknowledges receipt of amendment and remarks filed 2/14/07. Claims 29-43 are pending.

#### ***Response to Arguments***

**Previous rejections that are not reiterated herein are withdrawn.**

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 30-36 and 38 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is written description.

A lack of adequate written description issue arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996). In the present case, the claimed invention in claim 30 recites "at least one hydrophilic component." The specification at paragraphs [0043] and [0044] of the published application guides one to appreciate what applicant intends the hydrophilic component to be in at least structural sense but the guidance derived from the instant specification points to

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hydrophilic component that is defined solely by function terms without describing in concrete terms and structures what the components are. For example, water is hydrophilic so also is a host of other hydrophilic components such that the artisan would have to screen every component that is hydrophilic to arrive if at all at what applicant regards as hydrophilic component. Defining hydrophilic component strictly only by functional terms appears to lead the artisan on a hunting expedition.

An applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. This is lacking in the instant case

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406. This is also lacking in the instant case.

A "representative number of species" means that the species, which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the

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genus. The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]."

Applicant has not provided a description of the structure or chemical name of a representative number of compounds. In other words, the Applicant has not described with sufficient clarity a hydrophilic component that is the claimed invention.

### ***Response to Arguments***

3. Applicant's arguments filed 2/14/07 have been fully considered but they are not persuasive.

Applicant states that the amendment of claim 30 to state that the hydrophilic component has at least one water solubilizing group and one isocyanate reactive group over comes the rejection.

#### **Response:**

The amendment does not provide description of the structure or chemical name of a representative number of compounds with adequate clarity so that the artisan would not go on a hunting expedition to identify the specific hydrophilic compounds that would work in the claimed invention.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 29-32, 34, 36, 40, 41 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by de la Poterie et al. (US 5,972,354).

de la Poterie discloses cosmetic composition in the form of lipstick or foundation as recited in instant claim 41 (column 1, lines 9-14, 40-54) for application to the skin (column 1, line 9); the application of the composition meets the instant method of applying the composition to the skin. de la Poterie discloses the formation of a film over the skin or the lip upon application of the composition (column 1, lines 40-49), which meets film formation over the skin as in instant claim 1. The composition that is applied to the skin to form the film comprises polyester polyurethane, siloxane or organic compound having a sulfonic group, ethylene diamine that meets the chain extender limitation of the claims, glycols that meet the limitation of hydrophilic compound (column 3, lines 13-64) and dyes and pigments (column 5, line 62 to column 6 line 26) such that de la Poterie meets claims 29-32, 34, 36, 40, 41 and 43.

***Response to Arguments***

6. Applicant's arguments filed 2/14/07 have been fully considered but they are not persuasive.

Applicant argues that the silicones of de la Poterie are not hydrolyzable.

Response:

The claims are directed to method of using a cosmetic composition and the de la Poterie art meets the method as described in the rejection. The claims are not directed to method of hydrolyzing silicones or silyl groups.

7. Claims 29-32, 34, 36, 39, 40, 41 and 43 rejected under 35 U.S.C. 102(e) as being anticipated by Kantner et al. (US 6,433,073) or Scholz et al. (US 6,605,666).

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Kantner discloses polyurethane dispersion containing isocyanate terminated polyurethane having the structure in instant claims 38 and 43 (abstract; column 4, lines 13-19; column 9, lines 38-67); ethylene diamine (column 4, line 17) meeting the chain extender of claims 30 and 34; mixture of alcohol and water (column 4, line 10) meeting the hydrophilic compound of claim 30; diisocyanate and polyester diol (column 4, lines 15-17) meeting the isocyanate and diol limitations of claims 30-32; the polyols of Kantner have molecular weight of 62 to 10,000, preferably 200 to 5,000, and most preferably from 400 to 3,000 (column 6, lines 41-43) meeting claim 33; the composition is applied to the skin as foundation, moisturizer and is also applied to the nails (column 5, lines 21, 29-37) and when applied, the application process meets the generic method claims 29 and 30, the composition dries to a film of about 0.025 millimeter in thickness (claim 18) meeting instant claim 39. Therefore, Kantner anticipates the claims as designated.

Scholz discloses composition that is applied to the skin, which dries to 0.025 millimeter film in thickness (column 3, lines 41-50 and 61; claim 19) meeting claims 29 and 39. The composition of Scholz is a dispersion comprising silyl terminated polyurethane (column 9, lines 34-66), polyisocyanates, tertramethylene diisocyanate (column 7, line 55 to column 8 line 4), alcohol-water mixture (column 8, line 17) and carbowax (column 10, lines 21-30) that meets hydrophilic compound; polyalkylene diols or tetrols or triols (column 10, lines 4 and 43) or polyester diols, triols, or tetrols (column 10, line 44) that meet claims 29, 31 and 32; alkylene diamines (column 10, lines 43 and 44) that meet the chain extender of claim 34; surfactant (column 10, lines 25-34) as in instant claim 40. Scholz meets the claims.

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*Response to Arguments*

8. Applicant's arguments filed 2/14/07 have been fully considered but they are not persuasive.

Applicant argues that Kantner does not disclose hydrolyzed or hydrolysable silyl groups; that Scholtz does not disclose hydrolyzed or hydrolysable silyl groups.

**Response:**

Applicant defines "hydrolyzable silyl group" to generally mean "a silicon atom substituted with at least one moiety that will react with water to give a hydrolyzed silyl group," and the term "hydrolyzed silyl group" to generally mean "a silicon atom substituted with at least one --OH moiety." And "a polyurethane-urea that is functionalized with at least one hydrolyzed or hydrolyzable silyl group is also referred to as a silylated polyurethane-urea in this document" according to paragraph [0015] of the published application. Therefore, hydrolysable or hydrolyzed silyl groups read on the silicone polyols of Scholz (column 6, lines 64-66; column 7, lines 42-46) and Kantner (column 7, line 37; Example 4).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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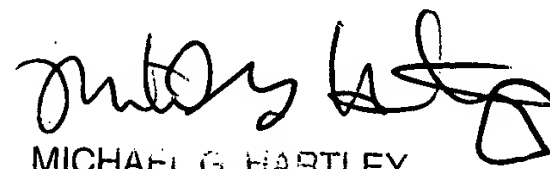
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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